No. 95-728

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.,
Petitioner,

v.

HILTON DAVIS CHEMICAL CO.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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SUPPLEMENTAL BRIEF FOR RESPONDENT IN OPPOSITION TO BRIEFS OF AMICI CURIAE

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LIST OF PARTIES PURSUANT TO RULES 14.1(B) AND 29.6

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief.

Respondent has the following parent and subsidiary companies:

Freedom Chemical Company (parent)

A Chem (UK) Limited (subsidiary)

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I. INTRODUCTION

This brief is submitted in reply to the Briefs of Amicus Curiae American Intellectual Property Law Association and Amicus Curiae Seagate Technology, Inc.[1] It addresses only those new issues raised that were not previously addressed in Respondent's Brief in Opposition.

II. ARGUMENT

A. The Issue of Infringement Under the Doctrine of Equivalents is, like Literal Infringement, an Issue of Fact to be Submitted to the Jury in a Jury Case.

The question of the right to a trial by jury of infringement under the Doctrine of Equivalents is so well settled that it should not be revisited by this Court. During the last 150 years, this Court has repeatedly stated that determination of infringement under the Doctrine of Equivalents is a question of fact to be submitted to a jury. *See Winans v. Denmead*, 56 U.S. (15 How.) 330, 344 (1853) ("[w]hether, in point of fact, the defendant's cars did copy the plaintiff's invention, in the sense above explained [i.e., equivalents], is a question for the jury, and the court erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative."); *Battin*

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[1] Respondent notes that Amicus Seagate Technologies, as well as several of the corporations joining in Seagate's brief, have been or are presently *defendants* in patent infringement litigation, and are, therefore, not totally disinterested.

v. Taggert, 58 U.S. (15 How.) 74, 85 (1854) ("questions of fact . . . such as the identity of the machine used by the defendant with that of the plaintiff's, or whether they have been constructed and act on the same principle," are questions "which come within the province of a jury"); *Tyler v. Boston*, 74 U.S. (7 Wall.) 327, 330-31 (1868) (whether one compound of given proportions is substantially the same as another compound varying in the proportions -- whether they are substantially the same or substantially different -- is a question of fact and for the jury); *Royer v. Schultz Belting Co.*, 135 U.S. 319, 325 (1890) ("the circuit court erred in not submitting to the jury the question of infringement, under proper instructions".)

In Chauffeurs, Teamsters and Helpers Local No. 391 v. Terry, 494 U.S. 558, 565 (1990), this Court gave clear instructions regarding the Seventh Amendment right to jury trial:

> [t]o determine whether a particular action will resolve legal rights, we examine both the nature of the issues involved and the remedy sought. "First we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we examine the remedy sought and determine whether it is legal or equitable in nature." [citations omitted] ... The second inquiry is the more important in our analysis.

Thus, *Chauffeurs* instructs that in assessing the right to jury trial, a comparison must be made between the action at issue and "18th-century actions brought in the courts of England prior to the merger of law and equity." *Id.* Patent infringement actions in 18th-century England were commonly brought at law and were tried to a jury. *See, e.g., Arkwright v. Nightingale*, 1 Websters Patent Cases 60, 64 (C.P. 1785); *Bramah v. Hardcastle*, 1 Carpmael 168 (K.B. 1789). The English Statute of Monopolies, 21 Jac. 1, C. 3 (1624), provided that patent infringement actions were to be heard at common law ("the force and validity of [letters patents], ought to be and shall be forever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise").

As part and parcel of the jury determination of patent infringement, the Doctrine of Equivalents developed in England in the law courts, and was tried to juries. In *Russell v. Cowley & Dixon*, 1 Websters Patent Cases 459, 463 (Ex. 1834), the question of colorable or substantial difference was referred to the jury. In *Morgan v. Seaward*, 1 Websters Patent Cases 167, 171 (Ex. 1836), the court (Alderson B.), instructed the jury that:

> the question would be, simply, whether the defendants' machine was only colourably different; that is, whether it differed merely in the substitution of what are called mechanical equivalents for the contrivances which were resorted to by the patentee . . . therefore the two machines are alike in principle, one man was the first inventor of the principle, and the other has adopted it, and though he may have

> carried it into effect by substituting one mechanical equivalent for another, still you [the jury] are to look to the substance and not to the mere form, and if it is in substance an infringement, you ought to find that it is so.

Again the court was referring to the well-known infringement by equivalents.

Thus, the above late eighteenth century English actions for patent infringement clearly show that infringement was tried to a jury as an action at law. Early nineteenth century actions in England applying the doctrine of equivalents also referred the issue to the jury. The right to jury trial in today's patent infringement cases (including those applying the doctrine of equivalents), is thus preserved as a right that was available in the identical action at law for patent infringement in pre-1791 English courts.

Chauffeurs also teaches that:

> [t]he right to a jury trial includes more than the common-law forms of action recognized in 1791; the phrase "Suits at common-law" refers to "suits in which *legal* rights [are] to be ascertained and determined in contradistinction to those where equitable rights alone [are] recognized, and equitable remedies [are] administered." [citation omitted] . . . ("[T]he amendment then may well be construed to embrace all suits which are not of equity and admiralty jurisdiction, whatever may be the peculiar form which they may assume to settle legal rights".) The

> right extends to causes of action created by Congress." [citation omitted]

Chauffeurs, 494 U.S. at 564-65.

In this country, in 1790 (before passage of the Seventh Amendment in 1791), Congress had provided for patent infringement "damages as shall be assessed by a jury" (Act of April 10, 1790, chapter 7, section 4, 1 Stat. 109). Therefore, before 1791 there was an action created by Congress which was identical to the present action for patent infringement and damages. The Act of 1790 made it clear that jury trial was available as a matter of right in this statutory action. As the Seventh Amendment reference to "suits at common law" has been interpreted to include "causes of action created by Congress" (*Chauffeurs*, 494 U.S. at 564-65), the Seventh Amendment preserved this right to jury trial in a patent infringement action seeking damages created by the Statute of 1790. That right continues to the present day.

As *Chauffeurs* instructs, determination of the most analogous or identical action is secondary to the determination of the nature of the relief sought. 494 U.S. at 570. Also, money damages was the traditional form of relief offered in courts of law. *Curtis v. Loether*, 415 U.S. 189, 196 (1974) In the present case, compensatory relief was requested and obtained by Hilton Davis in the district court.

A plaintiff is entitled to a jury trial when "the damages sought [are] neither analogous to equitable restitutionary relief . . . nor incidental to or intertwined with

injunctive relief" and "the remedy sought [is] legal." *Wooddell v. International Brotherhood of Electrical Workers,* 502 U.S. 93, 97 (1991). In the present case, the damages sought (and obtained) by Hilton Davis, are not incidental or intertwined with the injunctive relief sought (and obtained). Therefore, as in *Wooddell,* the remedy that Hilton Davis sought is legal.

Furthermore, of the remedies offered by the present patent statute, 35 U.S.C. §§ 283-285, only compensatory relief, namely damages and a reasonable royalty, is *required* to be awarded[2], assuming a finding of liability and evidence of record sufficient to support the damage award. In distinction, the historically equitable remedy of an injunction is discretionary[3]. The *compulsory* nature of damages/reasonable royalty after a finding of liability suggests that when Congress in 1952 enacted the several forms of relief that could be made available to vindicate the exclusionary rights specified in 35 U.S.C. § 154, it intended to insure the availability, in all cases, of compensatory relief, a form of relief traditionally granted by a jury in a court of law in 18th century England.

The right to jury trial on the claim for monetary relief is not lost by combining it with a claim for injunctive relief. *See, Beacon Theaters Inc. v. Westover*, 359 U.S. 500 (1959) (holding that the right to a jury trial of a *legal* claim

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[2] "[T]he court *shall* award the claimant damages . . ." 35 U.S.C. § 284.

[3] "The several courts . . . *may* grant injunctions . . ." 35 U.S.C. § 283.

involving *factual* issues such as liability under the Sherman Act and the Clayton Act, *cannot* be impaired by blending the legal claim with a demand for equitable relief), and *Dairy Queen Inc. v. Woods*, 369 U.S. 469 (1962) (holding that insofar as a complaint for trademark infringement requests a money judgment it presents a claim which is unquestionably legal and so long as *any* legal cause is involved in a case, even if the equitable causes clearly outweigh the legal cause, the jury rights created by the legal cause control).

In view of *Dairy Queen*, *Beacon Theaters*, *Chauffeurs* and *Wooddell*, it is clear that the nature of the remedy sought in the present case is legal. The issue of infringement under the Doctrine of Equivalents, is, like literal infringement, an issue of fact to be submitted to the jury in a jury case, as a *matter of right*, as the Federal Circuit in the decision below has now held. *Hilton Davis*, 62 F.3d at 1522. This principle is so well established that it does not require review by this Court.

B. The Federal Circuit's Unambiguous *En Banc* Ruling in *Hilton Davis* Obviates the Need for Further "Clarification" of the Test for Infringement Under the Doctrine of Equivalents

The American Intellectual Property Law Association (AIPLA) contends that the Federal Circuit's decision in *Hilton Davis,* considered with the benefit of the wisdom of the full membership of the court, is in need of further clarification. Without citing any supporting authority, the AIPLA contends that "there is an urgent need for this Court

to clarify the law" because there are views espoused in the *Hilton Davis* dissenting opinions that differ from the majority's holdings. It strains credulity to the breaking point to suggest that this Court should grant certiorari simply because of the mere existence of such differing viewpoints. Unanimity is the exception, rather than the rule, in both this Court and the various Federal Courts of Appeal[4]. Not only does the existence of differing opinions raise no cert-worthy issue, vigorous debate among those having differing views ensures that all important aspects of the issues addressed below were discussed and thoroughly analyzed. In *Hilton Davis,* a majority of the Federal Circuit unambiguously and clearly stated its position involving the three questions presented addressing the long-standing Doctrine of Equivalents. Accordingly, because the Federal Circuit in *Hilton Davis* has done nothing more than carry out its Congressionally mandated duty of clarifying and unifying the area of patent law, the granting of certiorari is unwarranted.

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[4] *See, e.g., United States v. Eichman*, 496 U.S. 310 (1990) (declaring state anti-flag-burning laws unconstitutional in a 5-4 decision).

CONCLUSION

For the foregoing reasons, the writ for certiorari should be denied.

Respectfully Submitted

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